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(4)

No. 08-1209

In The
Supreme Court of the United States

PELLA CORPORATION AND
W.L. GORE & ASSOCIATES, INC.,

Petitioners,

v.

ANDERSEN CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

REDACTED

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COUNTERSTATEMENT OF QUESTION PRESENTED

In 2002, Andersen Corporation solved a problem that had been plaguing the window and insect-screen industry for over one hundred years by inventing a reduced visibility insect screen. On summary judgment, the district court concluded that Andersen's invention was obvious. But the United States Court of Appeals for the Federal Circuit—recognizing that the prior art taught away from the invention and that many secondary considerations also favor Andersen—analyzed the issue of obviousness in detail under this Court's decisions in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), and other cases and reversed the district court, holding that material questions of fact exist regarding obviousness. Should this Court grant certiorari to review the Federal Circuit's reversal of summary judgment and, if so, is summary disposition by this Court appropriate in light of the disputed facts?

RULE 14.1(b) AND RULE 29.6 STATEMENT

Respondent Andersen Corporation has no parent company and no publicly held company owns 10% or more of Andersen Corporation's stock.

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STATEMENT OF THE CASE

This case is not a candidate for summary disposition under this Court's Rule 16.1—as the Petitioners request—nor is it a case for granting review on the merits. The facts are not "undisputed," as the Petitioners claim. But more to the point, the Federal Circuit's decision to vacate the district court's summary judgment on the issue of obviousness and remand for a trial does not conflict with this Court's decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The Federal Circuit's decision closely adheres to this Court's decision in *KSR*, to which the Federal Circuit referred throughout its opinion. The Petitioners gloss over many points of the lower court's analysis in their effort to convince this Court that it should grant their petition.

I. Andersen invents a reduced visibility insect screen

In the early 2000s, Respondent Andersen Corporation, the largest window and patio-door manufacturer in the United States, invented a reduced visibility insect screen. This invention solved a problem that had existed in the insect-screen and window industry for decades—making unsightly insect screens, which detract from the view out a window, less visible. After applying for patents on the technology, Andersen displayed a prototype of the invention in a secured, restricted-access location at a trade show for home builders in 2002. [redacted]

[redacted] In 2003, Gore applied for patents covering Andersen's invention, telling the Patent Office that there was a long-felt need for a reduced visibility insect screen and explaining the unexpected and surprising results the invention achieved. In 2004, Pella began selling its own less-visible insect screen, which it called VividView® and which is the infringing product in this case. Pella's screening material is manufactured by Gore.

A. The problem with conventional insect screens before Andersen's invention

Before Andersen's breakthrough invention, many companies sold insect screens. To serve their intended purpose, insect screens had to be durable: insect screens are subjected to high winds, high humidity, acidity, excessive direct sunlight, hail, sleet, snow, wind-blown debris, extreme temperatures, heavy rains, and corrosion from salt in the air. JA03576-77; JA03954-55.[1] Animals, jewelry, and children pose a

[1] Because Pella and Gore contend that this case presents a candidate for summary disposition under Rule 16.1, Andersen includes a detailed factual recitation in this brief, with citations to the Joint Appendix in the Federal Circuit. Despite their request for summary disposition, the Petitioners make no effort

(Continued on following page)

continual threat of damage to insect screens. JA06640; JA06833-34. To survive these elements and still permit ventilation while excluding insects, conventional insect screens typically consist of thick wires or fibers, woven in a grid pattern with horizontal and vertical elements. JA00039. Conventional insect screens most often had "18 elements per inch in one direction and 16 elements per inch the other direction, often expressed as being a 18 x 16 mesh," or having an 18 x 16 mesh count. JA00038. Common element diameters for these insect screens are 0.011 or 0.009 inch. *Id.* Manufacturers secure the insect screening material into a frame that is installed in a fenestration unit (a window or door). JA00039.

Once installed, conventional (prior art) insect screens obscured the view from inside a building looking out and darkened the view from the outside looking in. JA00038; JA04797. Although many other companies that sell insect screens have existed since the early 1900s, none of these companies manufactured or sold reduced visibility insect screens. JA03452, JA03508-09; JA03291-92; JA03305-06.

[redacted]

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to present all of the pertinent facts, nor do they construe the record in the light most favorable to Andersen, which they should do. They are asking this Court, as a failed movant for summary judgment, to grant certiorari review and summarily reverse the Federal Circuit's decision.

[redacted]

JA08072.

Before Andersen's invention, Pella, operating as the Rolscreen Company in 1925, tried to solve the problem of the visibility of conventional insect screens by rolling the screens up to the top of the window, removing them from sight. JA06410; JA06801. Other insect-screen manufacturers darkened screens in an attempt to make them less visible. JA0354-58. But dark insect screens dimmed the light from the window and did not solve the problem. JA00038. Many other companies made attempts to reduce the visibility of insect screens but also failed. [redacted] JA07620; JA07648-49; JA03995-98; JA00977; JA06464. Others, for example, tried a transparent film with perforations for ventilation, but this distorted the view rather than improving it. JA03997-98; JA02154-56; JA04464-65.

B. Andersen solved the problem that no one else could solve

Andersen began trying to make a reduced visibility insect screen in the early 2000s, as part of what Andersen called its Project Odyssey. JA04797; JA04628. Andersen first turned to its insect screen supplier, AMSCO, for help in developing an invisible insect screen. JA03390; JA03923-24; JA04464; AMSCO

tried to make an invisible insect screen out of clear fishing line, and also tried and tested a clear film material perforated with holes for ventilation. JA03995-98; JA04464-65; JA03990. In the end, both approaches failed, and AMSCO was unable to invent a reduced visibility insect screen. JA03990; JA03995.

Andersen then turned outside of the insect-screen and window industry to explore the problem. JA03990. Aspen Research, an Andersen subsidiary and "think tank" employing scientists with advanced degrees in chemistry, took the lead. JA04612; JA03989-90. Four chemists from Aspen Research ("the inventors") were tasked to solve the problem. JA04613; JA04671; JA04677; JA04796; JA04615. Told that Andersen essentially sought a force field that would repel insects, they began their investigation. JA04677. They studied a wide variety of materials, including metal screens, safety screens, pet screens, tree netting, and gnat screens, as well as different fabric materials like nylon. JA04629. They contacted Andersen's suppliers and other companies in the insect-screen business and searched the Internet for any available options. *Id.* Despite their efforts, the inventors learned of no earlier or existing insect screen that had the properties they were seeking, not even from Andersen's competitors and screen suppliers, including some decades-long fixtures in the industry. JA04679.

Through one of their increasingly-exhaustive Internet searches, the inventors located TWP, Inc.'s website. JA04634. Founded in the 1960s, TWP

distributes a wide-variety of materials, including specialty meshes. JA05217-18; JA06375. One of those specialty meshes is a fine, electromagnetic-shielding mesh. JA06375. Electromagnetic-shielding mesh materials shield electronic equipment from radio frequency electromagnetic interference in computer screens, MRI equipment, cathode ray tubes, and space shuttles. JA06375; JA05227. Some electromagnetic-shielding mesh is very fine, with many thin wires woven tightly together. TWP sells a fine, electromagnetic-shielding mesh with a 50 x 50 mesh count (meaning it has 50 wires/inch in both directions) and 0.0012 inch wire diameter. JA06375. TWP has been selling this electromagnetic-shielding mesh since at least as early as 1996, when TWP first started its website. JA05225; JA05237.

TWP's website advertised this fine, electromagnetic-shielding mesh as "the world's most delicate metal fabric," requiring "great care in handling." JA06375. TWP's website explained that the wire diameter is "many times finer than a single strand of human hair." *Id.* This electromagnetic-shielding mesh is delicate, easily damaged, and expensive; in use, it is sandwiched between glass or placed behind glass or a different material for protection. JA03985-86; JA05227; JA04680; JA06753; JA05228. [redacted] JA05227; JA05233.

TWP sold insect screening in another area of its website, but never connected the two. It did not advertise its electromagnetic-shielding mesh as insect screening and never thought to use it as insect screening. JA06373; JA06375. [redacted] JA05236-37; JA05231-32. [redacted] JA05232.

After locating this fine, electromagnetic-shielding mesh, the inventors ordered samples and began testing it. JA04635. The inventors noted that TWP's mesh consisted of very delicate wires that needed structural support. JA06752. It was polished, and had a high reflectance. JA06753-54. It was also very expensive and was not bonded at its intersections. JA03985-86; JA04639; JA04692; JA06377. Even with these flaws, the inventors still realized they were "onto something." JA04637.

The inventors modified the TWP electromagnetic-shielding mesh to develop insect-screen prototypes. JA04637; JA04638. After they installed the TWP electromagnetic-shielding mesh into a frame it was still very visible and shiny. JA04637. It was also still very fragile. *Id.* The inventors discovered that if they could bond the mesh's intersections with a coating

that would also darken the screen, they could make the mesh stronger and simultaneously reduce the glare and visibility. JA04692-93; JA04637-38. After darkening the TWP electromagnetic-shielding mesh and installing it in a frame for a fenestration unit, the inventors began the process of patenting their invention. JA04638; JA04639.

C. Andersen received patents for its invention

In February 2002, Andersen started applying for patents on its invention. JA00014; JA04639. On April 17, 2005, the United States Patent Office issued Andersen's Patent No. 6,880,612, which is the patent at issue here.[2] The '612 patent extensively describes the TWP electromagnetic-shielding mesh that the inventors located. JA00041-44. The specification teaches how the inventors changed the mesh to create an invisible insect screen. JA00041. It further teaches the transmittance and reflectance of the TWP electromagnetic-shielding mesh when covered with different coatings and colors, and how to coat the mesh to make it stronger and less visible. JA00041-44. The specification also teaches how the inventors'

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[2] The parent application to the '612 patent, which resulted in Andersen's United States Patent No. 6,763,875 (unasserted), was filed on February 6, 2002. JA00048-53. On February 9, 2004, the examiner allowed the claims of the '875 patent. JA01203-07.

modifications improved the mesh's optical properties. *Id.*

On May 6, 2004, the patent examiner initially rejected some of the original claims of the '612 patent as obvious in view of the TWP electromagnetic-shielding mesh in combination with a Japanese patent. JA00185-89. With Andersen's authorization, the examiner amended the claims to add the limitation "in a fenestration unit that permits ventilation therethrough," and allowed the claims. JA00264-69. The examiner explained that he allowed the amended claims because the prior art did not disclose the screen material in combination with the structure of a fenestration unit:

> The prior art does not disclose the screen material which has the structure recited which is used as an insect screen, which is claimed by way of reciting either the screen in combination with the structure of a fenestration unit or building structure or by reciting the method of using the screen material.

JA00269. The '612 patent issued on April 19, 2005, with "in a fenestration unit that permits ventilation therethrough" added as a limitation to every claim. JA00045-47. Exemplary claim 22 reads as follows:

> An insect screening material in a fenestration unit that permits ventilation therethrough having reduced visibility, comprising a plurality of screen elements having a diameter of 0.007 inch or less, the screen

> elements having a tensile strength greater than 5500 psi, wherein the screening has a transmittance of light of at least 0.75 and a reflectance of light of 0.04 or less.

JA00045.

II. Pella and Gore recognize Andersen's invention as a breakthrough; they copy it and Gore tries to patent it

At a trade show for home builders in 2002, as mentioned above, Andersen displayed the reduced visibility insect screen prototypes in a secured, restricted-access location in its booth, and allowed only attendees with invitations and proper identification to view the insect screens in the protected area. JA04686; JA05983; JA06770-71. The invisible insect screens were Andersen's "biggest hit," and many buyers were anxious to learn when they could purchase it. JA04638; JA04639. Others were so amazed that they did not believe that an insect screen was in the window. JA04857.

[redacted]

JA05983. [redacted]

[redacted] JA05983-85. [redacted]

[redacted] *Id.* [redacted]

Id.

[redacted] JA04311; JA06770-74; JA06824; JA07521-23. [redacted] JA06010-12. [redacted] JA06011. [redacted] JA06817-18; JA06820-23.

In August 2004, Pella began selling its Vivid-View® reduced visibility insect screens. JA04112-13; JA06795-96. [redacted] JA06003-04. [redacted]

[redacted] *Id.*

[redacted] JA06830. Pella touted its infringing VividView® insect screen as "virtually invisible," "unique," and "revolutionary," allowing for a view that is "crisper and clearer than ever before." JA06644; JA06646; JA04119-20.

Andersen's invention and its reduced visibility insect screen impressed Gore so much that Gore instituted efforts to obtain its own patents on an "Insect Screen with Improved Optical Properties" starting in 2003. JA01813. Gore declared under oath to the United States Patent and Trademark Office that there was "a long-felt need" for an invisible insect screen, JA06464, JA06421, and described the surprising results and favorable customer reactions to its infringing installed reduced visibility screen: "The surprising results achieved by applicant's invention are undeniable." JA06492. In fact, "it is difficult to overstate the excitement the transparency of the Gore Screen caused. Comments like 'amazing' and 'unreal' were typical." JA06498. In its patent applications, Gore admits that there was "a long-felt need" for an "invisible screen" and that many of its infringing product's features yield quite a surprising result:

> There are ***long-felt needs*** associated with current insect screen technology. These include the needs for improvement to optical transmission characteristics and airflow characteristics. In particular, there has been a ***long-felt need*** in the industry for an "invisible screen," one that is less visible and hence less obstructive of the view through the screen. It is ***surprising*** that using smaller fibers for the screen construction would be effective because more fibers would be needed to provide the same hole sizes, thus not providing any real improvement in visibility.

JA06421; JA06464 (emphasis added). Gore also stressed the surprising results and the favorable customer reactions its infringing product (which its patent application is intended to cover) garnered. In total, Gore asked the Patent Office six times for a United States patent and applied in Europe once. JA06507. Despite the positions Gore has taken during this litigation, Gore still maintains pending patent applications for a reduced visibility insect screen.

III. District-Court proceedings

On April 25, 2005, Andersen sued Pella and its supplier Gore for infringement of the '612 patent. JA01292-96. In late 2006, Pella and Gore moved jointly for summary judgment on the invalidity of then-asserted claims 12, 22-29, 55, 59, 65, and 76 of the '612 patent. JA01884-85. In an order filed on

October 2, 2006, the district court denied the motion, holding that genuine issues of material fact and law remained that precluded summary judgment. Pet. App. 36-37; JA08302; JA08386. After that initial summary-judgment motion, Andersen withdrew claims 12, 25, 26, 29, and 55 of the '612 patent from the suit. JA08423-24.

In 2007, a few weeks before trial, after this Court issued its opinion in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), Pella and Gore asked the district court to reopen summary-judgment proceedings in light of the decision in *KSR*. JA08490. The district court agreed and asked both sides to simultaneously exchange and file 10-page briefs on the issue. JA08490. Pella and Gore's brief addressed only the question of whether Andersen's invention was obvious in light of TWP's electromagnetic-shielding mesh. In its brief, Andersen pointed out that the electromagnetic-shielding mesh from TWP is missing the following elements from the asserted claims:

- an insect screening material in a fenestration unit that permits ventilation through the unit (all asserted claims);
- a reflectance of light of 0.04 or less (all asserted claims);
- a frame defining a frame opening; and the screening material of claim 22 attached to the frame around the frame opening;

- a reflectance of light of 0.03 or less (claim 27);
- a reflectance of light of 0.02 or less (claim 28); and,
- wherein the screen elements are bonded at their intersections (claim 65).

JA08670-71. Andersen argued that these significant and numerous differences and issues precluded summary judgment on the basis of the TWP reference. JA08669-71. Andersen also argued that the prior art and knowledge of someone of skill in the art taught away from starting with the TWP electromagnetic-shielding mesh, modifying it, and combining it with a fenestration unit. JA08668-69. Additionally, Andersen argued the overwhelming secondary considerations of nonobviousness, including the long-felt need, the failure of others, the unexpected results of Andersen's invention, copying by Pella and Gore, attempts to patent the invention by Gore, as well as praise by others, created genuine issues of material fact related to obviousness. JA08672-75.

Despite these arguments and issues, on July 31, 2007, the district court vacated its earlier order denying summary judgment and entered an order stating that "[t]he claims of [Andersen's] patent are obvious; thus, the patent is invalid as a matter of law." Pet. App. 32. Overreacting to *KSR*, the district court improperly relied on hindsight and the teachings of Andersen's patent to find the asserted claims obvious. Nothing about the directives of *KSR*

should have overshadowed the existence of genuine issues of material fact regarding whether someone of ordinary skill in the art would have started with or modified the TWP electromagnetic-shielding mesh when faced with the problem of making an insect screen with reduced visibility. In Andersen's view, the district court failed to construe all of the evidence in the light most favorable to Andersen. The district court also gave no consideration to overwhelming evidence of secondary considerations of nonobviousness and, instead, wrongly focused on the patent's teachings and invention story as its basis for invalidating the '612 patent claims in issue.

IV. Federal-Circuit proceedings

On November 19, 2008, the United States Court of Appeals for the Federal Circuit, in a lengthy unpublished opinion, vacated the judgment of the district court and remanded this matter for further proceedings. Pet. App. 1-19. The Federal Circuit concluded that genuine issues of material fact exist regarding whether someone of ordinary skill in the art—that is, someone who manufactures insect screens with no understanding of optics and physics —would have looked to TWP's electromagnetic-shielding mesh as material for a reduced visibility insect screen. Pet. App. 8. The Federal Circuit explained that the combination of the fact that TWP's mesh was not part of the field of the invention and that TWP's mesh actually taught away from the invention, "combined with the deference owed to the

PTO's issuance of this patent after reviewing the same prior art references that form the basis of this obviousness challenge, raises a genuine issue of material fact as to whether an ordinarily skilled insect screen designer would have found the combination of the TWP mesh with the other prior art references obvious." Pet. App. 9.

REASONS FOR DENYING THE PETITION

In its decision vacating the district court's summary judgment and remanding for further proceedings, the Federal Circuit rigorously applied the rule of law established by this Court. The Federal Circuit's opinion is replete with thoughtful analysis and application of this Court's ruling in *KSR*. Disappointed by the result, Pella and Gore are now looking to this Court for another hearing—another chance to make the same arguments that they made below. But their objective, as Chief Justice Taft explained in 1923, is not the purpose of this Court's certiorari jurisdiction: "The jurisdiction of the Supreme Court to review cases by way of certiorari was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing." *Magnum Import Co. v. Coty*, 262 U.S. 159, 163 (1923).

I. There is no conflict between the Federal Circuit's decision and this Court's ruling in *KSR*

Pella and Gore claim that "[e]very legal reason" given by the Federal Circuit for reversing the district court's summary judgment and remanding this matter for a trial conflicts with the Court's ruling in *KSR*. Pet. at 16. This is a sweeping charge, and one that does not hold up to analysis. The Federal Circuit's decision meticulously follows this Court's decisions on obviousness, including *KSR*. In discussing the Federal Circuit's obviousness analysis, Pella and Gore dismiss the significance of the lower court's findings regarding the scope and content of the prior art. The prior art for the patent at issue in *KSR* did *not* teach away from the invention, and this Court has long held that when prior art *does* teach away from the invention, that is evidence of nonobviousness.

A. In *KSR*, the Court did not reject the Federal Circuit's TSM test but instead required flexibility in the test

This Court has long stated that the "the primary responsibility for sifting out unpatentable material lies in the Patent Office." *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 18 (1965). Issued patents thus benefit from a presumption of validity, and an accused infringer must prove with clear-and-convincing evidence, under Section 103 of the Patent Act, that "the differences between the subject matter

sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a).

In *Graham*, the Court set out an objective framework for analyzing whether or not a claim is obvious under § 103 of the Patent Act. That objective framework—which the Court reaffirmed in *KSR*—involves several factual inquiries: the scope and content of the prior art; the level of ordinary skill in the art; the differences between the claimed subject matter and the prior art; and, many secondary considerations of nonobviousness, such as the commercial success of the invention, any long-felt but unsolved need, and the failure of others. 383 U.S. 1, 17-18 (1966). Hindsight and *ex-post* reasoning are not to enter into the obviousness analysis. *KSR*, 550 U.S. at 421. A factfinder must judge the patentability of the claimed invention at the time of the invention and from the viewpoint of someone of ordinary skill in the art. 35 U.S.C. § 103(a).

Beginning in the early 1960s, the Court of Customs and Patent Appeals and later the Federal Circuit began employing a test in its obviousness analyses to help achieve the "uniformity and definiteness" that *Graham* recognized as desirable in this area of law. This test—commonly known as the teaching, suggestion, or motivation test (or TSM test)—requires that someone challenging a patent as obvious show that the prior art, the problem's nature,

or the knowledge of a person having ordinary skill in the art revealed some motivation or suggestion to combine the prior-art teachings. *KSR*, 550 U.S. at 407. In *KSR*, the Court described the TSM test as a "helpful insight" into the determination of whether a patent is obvious, and the Court also found no "necessary inconsistency between the idea underlying the TSM test and the *Graham* analysis." *Id.* at 419.

Still, the Court concluded in *KSR* that the Federal Circuit in that instance had transformed the general principles of its TSM test into a "rigid rule that limits the obviousness inquiry": "The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published article and the explicit content of issued patents." *Id.* Although critical of the Federal Circuit's application of the TSM test in *KSR*, the Court also observed that "[s]ince the TSM test was devised, the Federal Circuit doubtless has [properly] applied" the test "in many cases." 550 U.S. at 402. In fact, the Court noted that the Federal Circuit had recently applied the TSM test in other cases in the flexible manner required by the Court. *Id.* at 421-22.

B. Here, nothing in the Federal Circuit's analysis conflicts with this Court's obviousness decisions

In this case, the Federal Circuit agreed with the district court that there were no genuine issues of

material fact on two of the primary factors established in *Graham* for determining obviousness: the differences between the claimed subject matter and the prior art, and the level of ordinary skill in the art. But the Federal Circuit disagreed with the district court with respect to the third primary factor—the scope and content of the prior art—*and* with respect to consideration of the many secondary factors that this Court has said can also inform the analysis (the district court gave no consideration to those factors).

The Federal Circuit explained that Andersen had presented evidence in the record that showed that "one, the TWP mesh was not part of the insect screen manufacturing field, and, two, [that] an insect manufacturer would have read the prior art to teach away from using a mesh with the characteristics possessed by the TWP mesh." Pet. App. 9. This evidence, explained the court, combined with the deference owed to the United States Patent and Trademark Office (which had determined that the invention is not obvious in light of the TWP mesh), "raises a genuine issue of material fact as to whether an ordinarily skilled insect screen designer would have found the combination of the TWP mesh with the other prior art references obvious." *Id.*

With respect to the evidence that the TWP mesh was not part of the insect screen manufacturing field, the Federal Circuit explained that TWP's website posted separate links for its insect screens and for the electromagnetic-shielding mesh that was used in the

invention. The part of TWP's website that related to its electromagnetic-shielding mesh described the mesh as "optical grade" for use in shielded windows and cathode ray tubes (CRTs). In contrast, as the Federal Circuit noted, "the 'Insect Screen' webpage noted the 'wide range of industrial and commercial applications' available for insect screening and did not include electromagnetic shielding meshes." Pet. App. 10.

The Federal Circuit specifically acknowledged the admonition of this Court in *KSR* that "common sense might make alternative uses of familiar items obvious and that design incentives and other market forces can prompt variations of a work," but it properly concluded that Andersen had presented evidence that required a jury to decide whether "the electromagnetic-shielding mesh would have been part of the field of invention searched by an insect screen designer and whether such an alternative use would have been obvious." Pet. App. 10. With respect to common sense and obviousness, the Federal Circuit also noted the compelling fact that TWP itself—a company that manufactures insect screens—did not use or think to use its electromagnetic-shielding mesh as an insect screen. This is one fact, as the Federal Circuit explained, that would suggest to a jury "that common sense and the nature of the problem to be solved might not have made it obvious to an insect screen designer to try using the mesh as an insect screen." Pet. App. 11.

With respect to the evidence that an insect manufacturer would have read the prior art as teaching away from using a mesh with the characteristics possessed by the TWP mesh, the Federal Circuit noted correctly that this Court, in *KSR*, cited *United States v. Adams*, 383 U.S. 39, 51-52 (1966), approvingly "for the 'principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." On this point, too, the Federal Circuit specifically recognized this Court's caution in *KSR* "to not be too rigid in applying the TSM test." But the Federal Circuit noted that this Court had still acknowledged the value of teachings as part of the obviousness inquiry: "Recognizing that the Supreme Court in *KSR* cautioned us to not be too rigid in applying the TSM test, we may still consider evidence of teachings to combine (and, presumably, not to combine) because, according to the Supreme Court, they 'capture[ ] a helpful insight' into the obviousness inquiry." Pet. App. at 13-14 (quoting *KSR*, 550 U.S. at 418). (In *KSR*, unlike in this case, there was *no evidence*, as this Court noted, that showed the prior art teaching away from the invention. *KSR*, 550 U.S. at 426.).

Here, the district court gave consideration only to what Pella and Gore argued was teaching-toward evidence and disregarded the teaching-away evidence. Pet. App. 13. The appellate court, on the other hand, properly refused to play the role of the jury. The Federal Circuit concluded that Andersen had

amassed a great deal of evidence that created a "genuine issue of material fact as to whether the durability, transparency, and pricing of the TWP mesh would have discouraged an ordinarily skilled artisan from incorporating the mesh into an insect screen." Pet. App. 11.

With regard to durability, for example, the Court found that "[t]he Sims Patent, a prior art reference also before the PTO examiner, teaches that fine mesh should only be removed from the glass panes if it will not be subject to accidental damage and contact." Pet. App. 11-12. Similar to the invention disclosed in the Sims Patent, the TWP mesh was advertised as the "world's most delicate metal fabric" and as requiring "great care in handling." JA06375. By contrast, insect screens must withstand significant wear and tear from exposure to daily weather conditions and interactions with humans and pets. Prior art thus teaches that "the delicacy of the TWP mesh, its need for special care, and its vulnerability to damage upon contact could discourage an insect screen designer from using it." Pet. App. 12.

With regard to transparency, the Federal Circuit took note of Andersen's evidence that the Sims Patent teaches that fine mesh produces optical *interference*, not invisibility (which is the main objective of the invention), if the wires are too fine. Pet. App. 12. In fact, the Sims Patent teaches to combine two layers of the mesh in an electromagnetic-shielding application, each with different spacing and grid patterns and angled over one another to eliminate the moiré "ghost

effect" that happens when a screen grid is too fine. JA06365-71. The TWP mesh qualifies as just such a "fine mesh"; it is advertised as containing wires that are "many times finer than a single strand of human hair." Thus, the Sims Patent, as the Federal Circuit explained, teaches away from using the TWP mesh to develop a reduced-visibility insect screen and "a person of ordinary skill in the insect screen art arguably would not think that increasing the number of wires in combination with decreasing the diameters of the wires would yield an insect screen with reduced visibility." Pet. App. 12.

The Federal Circuit noted that TWP advertises its electromagnetic-shielding mesh as "highly transparent." But the court correctly decided that a material question of fact exists regarding whether the TWP mesh was "highly transparent" relative to insect screens. Pet. App. 12. Pella and Gore highlight this finding regarding TWP's advertising as an example of the Federal Circuit's failure to follow *KSR*'s direction that the lower courts "need not seek out precise teachings directed to the specific subject matter of the challenged claim" in analyzing obviousness. But Pella and Gore are ignoring the context in which the Federal Circuit's conclusion was drawn—specifically the fact that the prior art teaches away on this exact point. If read in context, it is clear that a true fact question does exist about whether the prior art teaches away as to transparency, in light of the Sims Patent's teaching regarding the distracting effects of fine wire.

Finally, with regard to price feasibility, the Federal Circuit found the fact that the electromagnetic-shielding mesh was "extraordinarily expensive in comparison with traditional insect screen material" raised an issue of whether or not a person of ordinary skill in the art would look to or consider using this mesh in an insect screen. Pet. App. 18. Pella and Gore assign error to this finding on the ground that a price limitation was not included in the '612 patent and that the Federal Circuit did not discuss whether the TWP mesh was "somehow so flawed that there was no reason to upgrade it." Pet. at 24. But the Federal Circuit did not raise this issue as a claim limitation on the '612 patent; it raised it in the context of determining whether a person of ordinary skill in the art would consider using this mesh in an insect screen. Pricing considerations are demands that are known to the design community and common sense dictates that they can reasonably limit the scope of experimentation done by a person of ordinary skill in the art. Similarly, the pricing considerations do not have to render the TWP mesh "somehow so flawed that there was no reason to upgrade it" to make it a nonobvious choice for insect screening. Pella and Gore have cherry-picked this language from the Court's opinion in *KSR,* but, again, when considered in context and not in isolation, this argument fails.

In *KSR*, the issue of price was raised in the context of two adjustable automotive pedals. The patent-holder argued that its adjustable automotive pedal was not obvious in light of a pre-dating adjustable

automotive pedal (which it had not disclosed as prior art in its patent application) because the older model was more expensive. This Court held, absent evidence that the old pedal was so flawed because of this that there was no reason to upgrade it, that the patent was obvious in light of the prior art. The distinction between those facts in *KSR* and the facts in this case are stark.

First, unlike in *KSR*, the TWP mesh was disclosed and explained at length to the PTO before the patent-in-suit issued. Second, unlike in *KSR*, the prior art here is not an older version of the same basic product in the same field. The TWP electromagnetic-shielding mesh had never been used as an insect screen before and it had never been marketed as an insect screen before. It was expensive and taught away from the invention. For reasons such as these, the Federal Circuit correctly found that disputed issues of material facts regarding obviousness made summary judgment inappropriate.

C. The Federal Circuit correctly noted that the PTO proceedings in this case are distinguishable from those in *KSR*

In *KSR*, the United States Patent and Trademark Office had not considered the prior art that ultimately rendered the patent in that case obvious. Here, in contrast, as the Federal Circuit explained, the PTO specifically "considered whether the TWP mesh in combination with other references rendered

obvious the application that issued as the '612 patent." Pet. App. 15. The PTO analyzed TWP's electromagnetic-shielding mesh and also had before it the pages from TWP's website describing the electromagnetic-shielding mesh and its use in "shielded windows and cathode ray tubes." JA00014-16; JA00263-69. The PTO, in other words, fully appreciated the existence of the TWP electromagnetic-shielding mesh when it issued the patent. In fact, the PTO initially rejected the patent application in part on the basis of TWP's mesh. JA00185-89. After amending the claims to include the limitation of "a fenestration unit that permits ventilation therethrough," the PTO agreed that the claims were not obvious and allowed them. JA00259-69.

Pella and Gore acknowledge this difference with *KSR* in passing but they do not want to allow, as a consequence, any deference for the PTO's issuance of the patent. As the Federal Circuit observed, this was a failing of the district court as well: "We also note that, in ruling on summary judgment, the district court was required to view the evidence with an eye towards the burden on Gore and Pella to overcome the deference due to the PTO." Pet. App. 14. Under long-standing precedent, when a prior-art reference was before the PTO, the agency is presumed to have done its job, "'which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.'" Pet. App. 14-15

(quoting *Power-Oasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1304 (Fed. Cir. 2008)). This distinction with *KSR* is yet another reason why the Federal Circuit's decision is not in conflict with *KSR*.

D. The Federal Circuit explained that secondary considerations favor Andersen, which is also unlike *KSR*

Finally, in keeping with *KSR*, the Federal Circuit also addressed secondary considerations of nonobviousness. Pet. App. 16. Secondary considerations of nonobviousness, as the Court explained in *Graham*, "serve to guard against slipping into use of hindsight and to resist the temptation to read into the prior art the teachings of the invention in issue." 383 U.S. at 36. Secondary considerations also offer courts critical insight into the circumstances surrounding the invention, as the Court noted in *Graham* and *KSR*. *KSR*, 550 at 421 (quoting *Graham*). In *KSR*, the primary considerations weighed so heavily in support of invalidation of the patent that secondary considerations played no part in the Court's analysis. But the Court reiterated that, "when appropriate," courts should "look at any secondary considerations that would prove instructive." *KSR*, 550 U.S. at 415.

Here, the Federal Circuit also did not need to consider the secondary factors; the material issues of fact raised by the primary factors alone required denial of summary judgment, as the Federal Circuit

explained. Pet. App. 16. Nonetheless, the court noted "that the majority of secondary considerations favored" Andersen's position. Pet. App. 16. The court explained that Andersen had submitted evidence of "long-felt need, the failure of others, the unexpected results, copying by Gore and Pella, and praise by others"—all of which favor a finding of nonobviousness. Pet. App. 16. This evidence included:

- Gore's patent applications, which explicitly discuss "the long-felt need in the industry for an invisible insect screen"[3];
- evidence of the failures of others, including Pella, "to minimize visibility of insect screen by alternative methods";
- Gore's own patent application, in which Gore "acknowledged the 'surprising visual effects of the invention' and the unexpected results of the narrowly woven mesh";
- the praise by others for Andersen's invention, "including by Pella and Gore"; and,

---

[3] To date, the Patent and Trademark Office has not issued Gore a patent for its screens. Gore first filed its patent application on March 31, 2003 (App. No. 10/405,104). On February 13, 2008, Gore filed a continuation in part and abandoned its first application (App. No. 10/779,536). Gore has since filed continuations twice and has abandoned all but its most recent application, which was filed on August 7, 2008. (App. Nos. 11/335,879; 12/187,615).

- Pella and Gore's copying of Andersen's invention.

Pet. App. 16. All of these types of considerations, none of which were present in *KSR*, favored a finding of nonobviousness and encouraged vacating the district court's summary judgment.

II. The Federal Circuit's approach to obviousness is in accordance with *KSR* and does not need reform

This Court issued its opinion in *KSR* in 2007. Pella and Gore imply in their petition that in the two years since that decision the Federal Circuit has developed an institutional disregard for this Court's ruling in *KSR*. As Pella and Gore put it, "[t]he Federal Circuit either cannot or will not control its own case law." Pet. at 25. This is an unsubstantiated if not irresponsible statement. An accusation like that should be supported by *some* description and analysis of the Federal Circuit's decisions involving obviousness after *KSR*. But Pella and Gore make no such effort.

Pella and Gore do not cite a single decision from the Federal Circuit to support their sweeping statement about the Federal Circuit's supposed disregard of the law, and they do not include a word of analysis to support this attack on the lower court. Given the fact that the Federal Circuit is following *KSR*, as shown by the analysis above, there is no reason for this Court to grant the petition to review

what Pella and Gore perceive to be an error—a supposed error that will require nothing more than that the evidence of obviousness be heard at a trial.

III. The petition does not present an important question of law that should be settled by this Court

Pella and Gore assert that this "Court's grant of review in this case will affect every patent case in the United States where obviousness is asserted." Pet. at 2. This sweeping assertion rests on two premises: first, that this case was incorrectly decided by the Federal Circuit under *KSR*; and, second, that the Federal Circuit's narrow decision on these unique facts may be appropriately extrapolated into a rule of law. Both premises are wrong. As explained above, the Federal Circuit's decision properly applies the *KSR* holding and this Court's other decisions regarding obviousness to the facts of this case. Thus, there is no error to correct on review. Further, even assuming *arguendo*, that the Federal Circuit did misapply the rule of law from *KSR*, "a petition for a writ of certiorari is rarely granted when the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law." Sup. Ct. R. 10.

If this Court were to grant certiorari, it would not be to consider whether the Federal Circuit misapplied the rule of law from *KSR*. Instead, what Pella and Gore would have the Court do is correct a perceived

factual error, and the decision generated by the Court would likely be limited to the specific facts of this case—and not answer an important question of law.

IV. Summary disposition under Rule 16.1 is not appropriate

Contrary to Pella and Gore's suggestion, this case is *not* suited for summary disposition under Rule 16.1. Summary disposition is rare and exceptional and summary reversals are appropriate only when "full briefing and argument would be a waste of time" because the "lower court result is so clearly erroneous." Eugene Gressman et al., *Supreme Court Practice*, 344 (9th ed. 2007); *see, e.g.*, *Palmer v. BRG of Georgia,* 498 U.S. 46, 48-49 (1990) (summarily reversing lower court finding of no antitrust violation, in direct contradiction to established precedents). Summary disposition is more commonly used when an intervening decision of this Court or some other event such as new legislation prompts the Court to allow the lower court an opportunity to revisit its decision in light of the new information. *See Supreme Court Practice* at 344. Of course, no such circumstances exist in this case.

Here, to support their argument for summary disposition, Pella and Gore rely only on *Major League Baseball Players Ass'n v. Garvey*, 532 U.S. 504 (2001). *See* Pet. at 15-16. Pella and Gore's reliance on *Garvey* is misplaced. In *Garvey*, the Court granted certiorari and summarily reversed and remanded

because the United States Court of Appeals for the Ninth Circuit had ignored clear and long-standing precedent when—in an opinion that this Court described as "nothing short of baffling," 532 U.S. at 510—it reversed a district court and rejected an arbitration panel's findings, remanding the matter to the district court with instructions to remand the matter to the arbitration panel for entry of an award for the appellant in the amount that the appellant had claimed. *Id.* at 508. Here, the Federal Circuit did not ignore the binding precedent of *KSR* and there is nothing "baffling" about its decision. To the contrary, as discussed above, the Federal Circuit extensively analyzed and followed this Court's ruling in *KSR*. No extraordinary circumstances exist for summary disposition.

CONCLUSION

Pella and Gore are disappointed with the Federal Circuit's review of the merits of Andersen's appeal and they are now looking to this Court for another hearing—a third chance to convince a court that they are right. To accomplish this, they have drawn an unfair and unsubstantiated picture of the Federal Circuit's obviousness jurisprudence in general and the result in this case in particular. The purpose of this Court's certiorari jurisdiction is not to allow litigants a third chance for a hearing on the merits for a defendant's motion for summary judgment. The petition for certiorari should be denied.

Date: April 30, 2009

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REPLY BRIEF

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In The
Supreme Court of the United States

PELLA CORPORATION AND
W.L. GORE & ASSOCIATES, INC.,

Petitioners,

v.

ANDERSEN CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

REPLY BRIEF

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REPLY

The Court should summarily reverse the Federal Circuit's decision under Rule 16.1 because it repeats the same legal errors that this Court painstakingly corrected in *KSR Int'l Co.* v. *Teleflex, Inc.*, 550 U.S. 398 (2007). Under the correct legal standard, the simple insect screen at issue in this case is obvious as a matter of law because the only differences between the claimed screen and commercially available TWP wire screening were black paint and a frame—and those were obvious things to add. The alleged factual issues that Respondent raises are legally immaterial. They address secondary considerations that cannot overturn a clear showing of obviousness based on the three primary factors established in *Graham* v. *John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966).

1. Respondent cannot reconcile the Federal Circuit's reliance on three characteristics that are not claimed by the '612 Patent—"durability, transparency, and price feasibility" (App. 13)—with this Court's unambiguous holding in *KSR* that, in measuring obviousness, the claims are all that matters:

> In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.

550 U.S. at 419. Here, it is undisputed that the claims of the '612 Patent extend to an insect screen made from the obvious combination of TWP screening, black paint, and a frame in a door or window. The claims are therefore invalid under § 103.

Respondent argues that the prior art taught away from using TWP screening to make an insect screen because it lacked the ideal qualities of durability, transparency, and price feasibility. The relevant question, however, is not whether it possessed those ideal qualities but whether it possessed the qualities *claimed by the '612 Patent*. *Graham* instructs that courts must measure the "differences between the prior art *and the claims at issue*." 383 U.S. at 17. *KSR* likewise holds that "[w]hat matters is the objective reach of the claim." 550 U.S. at 419. *See also* Pet. 19-20 (citing cases). For teaching away to be relevant, the prior art must teach away from the claimed invention, not something else. *In re Peterson*, 315 F.3d 1325, 1331 (CAFed 2003) (patentee must "show[] that the prior art teaches away from the claimed invention"). Respondent does not cite a single case holding that obviousness may be denied because, although it would have been obvious to use the prior art to make the claimed invention, it would not have been obvious to use it to make a different invention. It is undisputed here that blackened TWP screening had all the qualities required by the '612 Patent claims: (1) the tensile strength, (2) the light transmission and reflectance, (3) the screen element diameter, and (4) the mesh opening dimension. No

claim required the screen to be durable. No claim required it to be transparent. No claim required it to be inexpensive. The Federal Circuit committed clear error by measuring the TWP screening against these unclaimed, idealized qualities instead of against the qualities claimed by the '612 Patent.

The Federal Circuit's decision also directly conflicts with *KSR* by relying on "[t]he fact that TWP's use for the mesh was electromagnetic shielding" instead of insect screening as a basis for finding non-obviousness. (App. 11) This Court held that it is an "error" to assume "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem." *KSR*, 550 U.S. at 420. Respondent's defense of the Federal Circuit's decision on this point is to call it a "compelling fact" that TWP "did not use or think to use its electromagnetic-shielding mesh as an insect screen." BIO at 22. That simply repeats the *ipse dixit* argument that this Court rejected.

Respondent finally argues that Petitioners have not shown that the Federal Circuit is making these errors in every case. True, it is not, and Petitioners do not contend otherwise. But that was the case before *KSR* as well. *KSR* acknowledged that the Federal Circuit "no doubt" had conducted a proper analysis "in many cases." 550 U.S. at 419. Yet the Court granted review to ensure that no case would be decided based on the "fundamental misunderstandings" that the Federal Circuit expressed in that case. *Id.* at 422. To have the Federal Circuit apply *KSR* in

some cases but not others—to decide some cases correctly but make the same fundamental errors that this Court expressly corrected in others—is to leave the state of obviousness law in the same inconsistent place it began. The Court's holding in *KSR* is entitled to greater efficacy.

2. Under the proper legal approach, the district court was correct to grant summary judgment holding that the insect screen claimed by the '612 Patent was obvious as a matter of law. Under the first *Graham* factor, the TWP screen was relevant prior art because, "[w]hile the [TWP screen] is not designed specifically for application to the [insect screen] industry many of its characteristics and capabilities are similar to those of respondent's system." *Dann* v. *Johnston*, 425 U.S. 219, 228 (1976). Under the second *Graham* factor, respondents concede in their opposition that only three differences separate the TWP screening and the claims of the '612 Patent: (1) placement in a frame in a window or door; (2) a reflectance value of 0.04, 0.03, 0.02 or less; and (3) bonding of the screen elements at their intersections. BIO 14-15; *see also* App. 8, 26. Under the third *Graham* factor, it is undisputed that a person of ordinary skill in the insect screen art knew to paint screens black to reduce their reflectance and bond the elements and to place painted screens in a frame to make an insect screen. Pet. 8-9. The insect screen claimed by the '612 Patent truly is what *KSR* described as the plainest case of obviousness: "the mere application of a known technique to a piece of prior

art ready for the improvement." 550 U.S. at 417. All the '612 Patent teaches is to start with a less visible commercial wire screen to make a less visible insect screen. If this most obvious of claimed inventions cannot be held obvious on summary judgment, *KSR* was decided for naught.

3. The facts that Respondent spends much of its brief discussing do not remedy the Federal Circuit's legal errors or prevent summary reversal by this Court because they are legally immaterial. Respondent's extended discussion of its own invention story, in which it is ultimately forced to admit that all it did was "darken[ ] the TWP . . . mesh and install[ ] it in a frame," BIO 8, is legally irrelevant. Claimed inventions must stand on their own merits, not on their invention stories. Inventions cannot be held obvious based on "the manner in which the invention was made," 35 U.S.C. § 103, and "the converse is equally true." *Pfizer, Inc.* v. *Apotex, Inc.*, 480 F.3d 1348, 1369 (CAFed 2007). An inventor cannot manufacture patentability by taking an unnecessarily tortuous route to an obvious destination. "The question is not whether the combination was obvious to the *patentee* but whether the combination was obvious to a person with ordinary skill in the art." *KSR*, 550 U.S. at 420 (emphasis added).

Respondent's discussion of the supposed long-felt need for its invention and Pella's and Gore's alleged copying of its invention also does not create a material issue of fact because those factors cannot change the judgment of obviousness. Long-felt need and

copying are secondary considerations that may "give light to the circumstances surrounding the origin of the subject matter sought to be patented." *Graham*, 383 U.S. at 17-18. But they cannot, as a matter of law, overcome a sufficiently strong showing of obviousness based on the primary *Graham* factors. In *KSR*, this Court devoted its entire opinion to a discussion of the primary *Graham* factors, then concluded simply that, "[l]ike the District Court . . . we conclude [the patentee] has shown no secondary factors to dislodge the determination that [the claimed invention] is obvious." 550 U.S. at 426. The Federal Circuit likewise has recognized in other cases that, when there is a "strong showing of obviousness" based on the primary factors, evidence of secondary considerations cannot create an issue of fact to prevent summary judgment. *Pfizer*, 480 F.3d at 1372; *see also Agrizap, Inc.* v. *Woodstream Corp.*, 520 F.3d 1337, 1344 (CAFed 2008); *Dystar Textilfarben GmbH* v. *C.H. Patrick Co.*, 464 F.3d 1356, 1371 (CAFed 2006). Because the invention claimed by the '612 Patent is so clearly obvious based on the primary *Graham* factors, Respondent's arguments about secondary factors are immaterial as a matter of law.

Respondent's arguments are also legally unfounded. "[C]opying requires the replication of a specific product." *Iron Grip Barbell Co.* v. *USA Sports, Inc.*, 392 F.3d 1317, 1325 (CAFed 2004). Here, it is undisputed that Pella and Gore did not copy the prototype screen made from painted TWP stainless steel wire mesh that Respondent displayed. Instead,

they developed a different screening material using uncoated PVDF (polyvinylidene fluoride) plastic fibers having a different element diameter and mesh count. Respondent's alleged invention also did not meet a long-felt but unmet need. If any long-felt need existed, it was for a sturdy, less visible insect screen. Respondent invented no such screen. Instead, its claimed invention encompasses a screen that is thirty times *weaker* than the TWP screen. *Compare* App. II-32, claim 22 (requiring a tensile strength of 5500 psi) *with* App. II-29, col. 10:65-67 (showing that TWP screening had a tensile strength of 162,000 psi).

As this Court held long ago, a person "who merely finds new uses for old inventions by shutting his eyes to their prior disadvantages" does not "thereby discover[ ] a patentable innovation." *United States* v. *Adams*, 383 U.S. 39, 52 (1966). Respondent did not solve a durability problem; it simply shut its eyes to the disadvantages of using flimsy screening. That is not a patentable innovation. The district court correctly granted summary judgment holding that the screen claimed by the '612 Patent was obvious. This Court should summarily reverse the decision of the Federal Circuit vacating that judgment.

CONCLUSION

Petitioners respectfully request the Court to summarily reverse the decision of the Federal Circuit. In the alternative, the Court should summarily

correct the Federal Circuit's legal errors that directly conflict with *KSR* and remand for further consideration under the proper standard.

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